




FISH &amp; RICHARDSON P.C.

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 00216-368005/OB-84E
<p>I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.</p> <p><u>January 31, 2006</u> Date of Deposit</p> <p>_____ Signature</p> <p><u>Sherry L. Hunt</u> Typed or Printed Name of Person Signing Certificate</p>	Application Number 10/692,916	Filed October 24, 2003
	First Named Inventor Michael F. Roberts	
	Art Unit 1744	Examiner Mark Spisich
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record (Reg. No.) 33,431</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.</p>		
<p><input checked="" type="checkbox"/> Total of 6 pages are being submitted (including this page)</p>		

  
\_\_\_\_\_  
Signature  
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Telephone number  
January 31, 2006  
\_\_\_\_\_  
Date



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Michael F. Roberts et al.                      Art Unit : 1744  
Serial No. : 10/692,916    Examiner : Mark Spisich  
Filed : October 24, 2003  
Title : GUM MASSAGING ORAL BRUSH

**MAIL STOP AF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REMARKS SUBMITTED WITH PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with a Notice of Appeal. Review of identified matters by a panel of Examiners is requested because the rejections of record are clearly not proper in view of a clear legal or factual deficiency in the rejections.

Claims 55 and 57-60 are pending; claim 55 being the only claim in independent form. Claims 55, 57 and 58 stand rejected as being obvious over Lion Corporation, Japanese Unexamined Utility Model Application No. 1-72128 ("J-128"), in view of Dolinsky, U.S. Patent No. 4,288,883 ("Dolinsky") and Kuan et al., U.S. Patent No. 4,833,194 ("Kuan"); and claims 59 and 60 stand rejected as being obvious over J-128, in view of Dolinsky and Kuan, as applied to claim 55, and further in view of Muhler et al., U.S. Patent No. 3,613,143 ("Muhler").

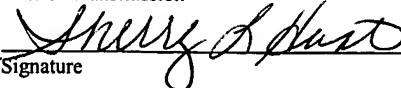
Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness. Claim 55 features an oral brush that includes, in pertinent part, one or more elastomeric element(s), the elastomeric element(s) including a thermoplastic elastomer having a Shore A hardness of 30 or greater, the thermoplastic elastomer including an *oil plasticized styrene-ethylene-butylene-styrene block copolymer*. Applicants have found that the addition of an oil to the elastomer desirably lowers the coefficient of friction of the element or elements

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I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office on the date indicated below.

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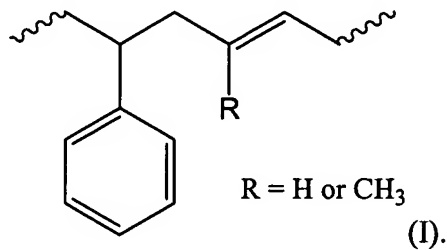
  
Signature

Sherry L. Hunt

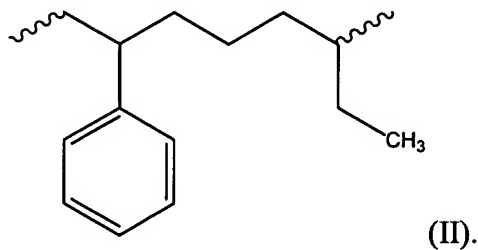
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(especially when wet), improving mouth feel, safety, and comfort, and improving the ability of the elastomeric element or elements to slide between teeth to provide a clinical benefit.

J-128 discloses an oral cleaning implement employing filaments composed of an engineering elastomer. Styrene-butadiene-styrene ( $R = H$ ) and styrene-isoprene-styrene ( $R = CH_3$ ) copolymers are disclosed, which may be represented by Structure I (shown below)



In contrast, claim 55 requires a styrene-ethylene-butylene-styrene block copolymer, which may be represented by Structure II (shown below)



In addition to not disclosing or even suggesting the required elastomer, J-128 does not disclose or even suggest the *oil* required by claim 55.

Dolinsky discloses a combined toothbrush and gum massaging device that includes a plurality of relatively stiff bristles and one or more rows of massaging elements. Dolinsky does not disclose or even suggest a *styrene-ethylene-butylene-styrene block copolymer*, much less an *oil plasticized styrene-ethylene-butylene-styrene*, as required by claim 55.

Kuan describes blending amorphous and crystalline polymers to form thermoplastic elastomer blends. The thermoplastic elastomer blends include amorphous ethylene-propylene-type rubber, crystalline ethylene-propylene-type rubber, and crystalline olefins such as

polyethylene. Kuan discloses styrene-butadiene-styrene block copolymers in his Background, and in his Examples (col. 5, lines 40 through col. 6 line 16) to show that his new compounds are superior to these styrene-butadiene-styrene block copolymers. However, Kuan does not disclose or even contemplate a *styrene-ethylene-butylene-styrene block copolymer*, as required by claim 55. Kuan discloses that various compatible processing aids and plasticizers, such as oils, may be used to reduce the viscosity of his new blends. However, Kuan does not disclose or even suggest an *oil plasticized styrene-ethylene-butylene-styrene block copolymer*, because, as described above, Kuan does not even disclose or suggest the required *styrene-ethylene-butylene-styrene block copolymer*.

To establish a *prima facie* case of obviousness, the Examiner must establish (1) that the prior art reference (or references when combined) teach or suggest all the claim limitations; and (2) that there is some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or references, or to combine reference teachings; and (3) that there is a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. (MPEP §2143).

With regard to (1) above, Applicants respectfully submit the prior art references, when combined, do not teach or suggest all the limitations of claim 55. In particular, none of the prior art references teach or suggest a *styrene-ethylene-butylene-styrene block copolymer*, much less an *oil plasticized styrene-ethylene-butylene-styrene block copolymer*, as required by claim 55. Thus, for this reason alone, a *prima facie* case of obviousness has not been established.

Moreover, with regard to (2) and (3) above, there is no motivating disclosure in the references of record that would have led one of ordinary skill in the art to look to Kuan. The Examiner apparently believes that the disclosure in Kuan that various compatible processing aids and plasticizers, such as oils, may be used to reduce the viscosity of Kuan's blends would have motivated someone of skill in the art to use an *oil plasticized styrene-ethylene-butylene-styrene block copolymer* in the oral care devices of J-128 or Dolinsky. Applicants believe that this is a clear factual error. Applicants note that there were hundreds of elastomers on the market at the time of Applicant's disclosure that did not include a plasticizer, and that there were hundreds, or

perhaps even thousands, of plasticizers then on the market that could have been used if one desired to use a plasticizer in a particular formulation. The references directed to oral care do not suggest that any of the disclosed elastomers need to be plasticized at all; and even if they did, what is the motivation to select an *oil* as the particular plasticizer? Applicants respectfully submit that the Examiner has simply used the Applicants' claims as a roadmap to make an artificial connection between disparate art in order to reject the Applicants' claims. It is axiomatic that obviousness cannot be established by simply stitching together disparate pieces of prior art using the Applicant's claims as a template (see, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132; Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861; and In re Fine, 837 F.2d 1071) because Applicants' claims are not disjointed lists of elements, but present an invention that must be considered *as a whole* (see, e.g., MPEP 2141.02, and Stratoflex, Inc. v. Aeroquip, 713 F.2d 1530).

Regarding the rejection of claims 59 and 60 as being obvious over J-128, in view of Dolinsky and Kuan, as applied to claim 55, and further in view of Muhler et al., U.S. Patent No. 3,613,143 ("Muhler"), Applicants submit that Muhler is directed a brush having abrasive-impregnated bristles, and does not disclose or even suggest an *oil plasticized styrene-ethylene-butylene-styrene block copolymer*, as required by claim 55. Accordingly, Applicants submit that claims 59 and 60 are allowable for at least the reason that they depend from allowable base claim 55.

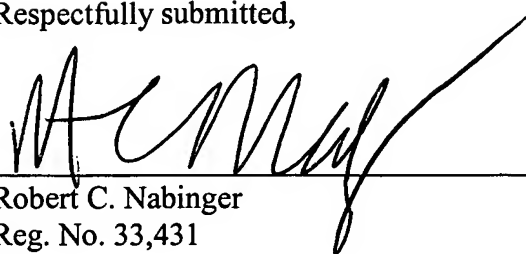
Applicants respectfully submit that none of the rejections made by the Examiner are proper for at least the reasons set forth above. As such, Applicants respectfully submit that claims 55 and 57-60, as presented in Applicants' May 17, 2005 Response to Office Action, are in condition for allowance.

Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 00216-368005.

Applicants: Michael F. Roberts et al.  
Serial No. : 10/962,916  
Filed : October 24, 2003  
Page : 5 of 5

Attorney Docket No.: 00216-368005 / OB-84E

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Nabinger', is written over a horizontal line.

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Date: January 31, 2006

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